

### REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow.

Claims 25-27 and 29-46 are pending in the application, Claim 28 having been canceled above without prejudice or disclaimer.

By the above Amendments, Applicants have amended Claim 25 to read, in part, “. . . a catalyst comprising a metallic element comprising nickel . . .” Applicants also amended Claim 36 and canceled Claim 28 in view of the amendments to Claim 25.

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119 and for indicating that all certified copies of the priority documents have been received by the International Bureau. Applicants also thank the Examiner for acknowledging that Claims 25-46 are free of the art.

Turning now to the Official Action, Claims 25-46 stand objected to for containing elected and non-elected subject matter. By the foregoing amendments, Applicants have amended the claims to attempt to remove non-elected subject matter. Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to Claims 25-46.

Claims 25-46 stand rejected under 35 U.S.C. § 112, first paragraph, for not meeting the written description requirements. For at least the reasons that follow, withdrawal of the rejection is in order.

It is understood that the subject matter defined in the claims of an application need not be described literally or in “ipsis verbis” for the specification to satisfy the

written description requirement. (See for example, In re Lukach, 42 F.2d 967, 969, 169 U.S.P.Q. 795, 796 (C.C.P.A. 1971).) It is sufficient that the specification “convey directly to those skilled in the art the information that the Applicant has invented the specific subject matter later claimed.” (See, for example, In re Wertheim, 541 F.2d 257, 261, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976) and In re Ruschig, 379 9 F.2d 990, 996, 154 U.S.P.Q. 118, 123 (C.C.P.A. 1967).) The Patent Office always has the burden of demonstrating that the applicant has failed to comply with the written description requirement. (See In re Edwards, 568 F.2d at 1356, 196 U.S.P.Q. at 469 and In re Selim, 553 F.2d 676, 682, 193 U.S.P.Q. 513, 518 (C.C.P.A. 1977).)

Furthermore, determining whether the written description requirement is satisfied, requires one to read the disclosure in light of the knowledge possessed by those skilled in the art, which can be established by affidavits of fact composed by experts and by reference to patents and publications available prior to the filing date of the application. (See, for example, In re Alton, 76 F.3d 1168, 37 U.S.P.Q. 2.d 1578 (Fed. Cir. 1996).)

Applicants submit that the specification of the instant application does clearly convey to those skilled in the art that Applicants invented, *inter alia*, a “process for hydrocyanating a hydrocarbon compound containing at least one ethylenic unsaturation by reacting it in a liquid medium with hydrogen cyanide in the presence of a catalyst comprising a metallic element selected from transition metals and an organic ligand, wherein the organic ligand corresponds to the general formula (I).” For example, the specification at page 37 describes metals that may be complexed by the claimed organic ligands to include generally all transition metals of groups 1b, 2b, 3b, 4b, 5b, 6b, 7b and 8 of the Periodic Table. The specification also explains

that among these metals, mention may be more particularly made of nickel, cobalt, iron, ruthenium, rhodium, palladium, osmium, iridium, platinum, copper, silver, gold, zinc, cadmium and mercury. The specification provides even more discussion of exemplary metallic elements and suitable properties thereof on pages 38-41.

Nevertheless, in an effort to expedite prosecution of the instant application, Applicants have amended Claim 25 to specify that the metallic element is one comprising nickel (one of the exemplary transition metals described in the instant application's specification). Applicants, of course, reserve the right to pursue broader patent protection in a subsequent continuing application.

In view of Applicants' amendment to Claim 25, further specifying that the metallic element is one comprising nickel, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph, rejection of Claims 25-46.

Claims 36-42 and 46 stand rejected under 35 U.S.C. § 112, first paragraph, for not complying with the written description requirement. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action alleges that the specification only provides support for using  $\text{ZnCl}_2$ ,  $\text{CoCl}_2$  and  $\text{YCl}_3$  as Lewis acids in the catalyst composition for the instant process. The Official Action further alleges that the with the array of Lewis acids that can be included, Applicants have not provided a representative number of examples to lead one of skill to conclude that Applicant was in possession of the entire claimed invention at the time of filing. Applicants respectfully disagree. To satisfy the written description requirement of § 112, first paragraph, it is sufficient that the specification convey clearly to those skilled in the art the information that the

Applicant has invented the specific subject matter claimed. (See In re Wertheim, 541 F.2d at 262, 191 U.S.P.Q. at 96 (C.C.P.A. 1976).) Applicants submit that the instant specification satisfies this requirement.

Beginning at page 43, the specification provides a detailed description of exemplary Lewis acids that can be used in accordance with the claimed process. For example, at page 43, line 27, the specification generally explains that "A Lewis acid in the present text, according to the usual definition, refers to compounds that accept electron pairs." In the next paragraph, the specification further explains that "Use may be made in particular of the Lewis acids cited in the work edited by G.A. Olah, "Friedel-Crafts and Related Reactions", volume I, pages 191 to 197 (1963)." The specification also states that "The Lewis acids which may be employed as cocatalysts in the present process are selected from the compounds of the elements of groups Ib, IIb, IIIa, IIIb, IVa, IVb, Va, Vb, VIb, VIIb and VIII of the Periodic Table of the Elements." It is also explained that these compounds are often salts. Page 44 of the specification also provides a detailed, non-limiting list of exemplary Lewis acids. It is further explained that as a Lewis acid it is possible to use organometallic compounds such as triphenylborane or titanium isopropoxide. (See specification at page 44, line 21-23.) The specification also contemplates the use of mixtures of two or more Lewis acids.

Accordingly, Applicants submit that the specification and its lengthy, detailed discussion of exemplary Lewis acids (both generally and specifically) would have clearly conveyed to those skilled in the art that Applicants had invented a process for hydrocyanating a hydrocarbon compound in the presence of a catalyst system comprising at least one transition metal compound comprising nickel, at least one

organic compound of formula (I) and a cocatalyst composed of at least one Lewis acid. Indeed, from the significant discussion of exemplary Lewis acids in the specification, those of ordinary skill would have understood that Applicants were in possession of a process employing any suitable Lewis acid that would achieve the desired objectives of the claimed hydrocyanating process. Furthermore, as the Official Action acknowledges, at the time the application was filed, those of ordinary skill in the art were well aware of the existence of numerous Lewis acids, including those specifically described in the specification as well as others falling within the more general description provided in the specification. Of course, numerous patents and publications available to the public prior to the application's filing date confirm this.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph, rejection of Claims 36-42 and 46.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

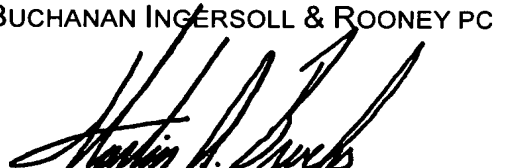
If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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